IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Tam, et al.	§		
Serial No.: 10/074,345	§	Group Art Unit:	3723
Confirmation No.: 5690	§	Examiner:	Shantese L. McDonald
Filed: February 12, 2002	§		
For: STI POLISH ENHANCEMENT USING FIXED ABRASIVES WITH AMINO ACID ADDITIVES	§	Appeal No.:	2007-2310

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

CERTIFICATE OF TRANSMISSION

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Nov. 14, 2008 — Steven H. VerSteeg
Date

REQUEST FOR RECONSIDERATION

Appellants respectfully request reconsideration of the Decision on Appeal mailed by the Board on January 30, 2008, for the reasons discussed below. This request is filed by the due date of March 30, 2008. Please charge any fee due for this request to Deposit Account No. 20-0782/APPM/006075/KMT.

The Examiner has rejected claims 1-25 and 30-38 under 35 U.S.C. § 103(a) over United States Patent No. 6,544,892 B2 to *Srinivasan et al.* in view of United States Patent No. 6,599,174 B1 to *Spikes, Jr.* The Board relied upon *KSR Int'l Co. v. Teleflex Inc.*[1] to affirm the Examiner's rejection of claims 1-25 and 30-38, concluding that the Examiner appropriately relies on *Spikes, Jr.* only for the teaching of a pre-polishing step and notes that Appellants' argument "appears to attack Spikes individually, rather than

[1] 127 S.Ct. 1727 (2007)

the combination of Srinivasan and Spikes proposed by the Examiner." (*See* Decision on Appeal decided January 30, 2008, page 6).

Appellants respectfully assert that the Board has improperly ignored the motivation and suggestion cited by the Examiner and substituted a different reason for the rejection. Thus, Appellants have not, until the submission of this Request for Reconsideration, been given an opportunity to address the rejection that is "affirmed" by the Board.

The Examiner rejected claims 1-25 and 30-38 over *Srinivasan et al.* in view of *Spikes, Jr.* under 35 U.S.C. § 103(a). In the rejection, the Examiner utilized motivation to combine *Srinivasan et al.* and *Spikes, Jr.* Specifically, the Examiner stated that "It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the polishing method of Srinivasan et al. with a pre-polish step, a carousel, first and second platens and a controller, in order to remove the bulk overfill of dielectric material and more efficiently polish the substrates." (*See* Final Office Action, page 3; Examiner's Answer, page 4).

In the Appeal Brief, Appellants argued the combination of *Srinivasan et al.* and *Spikes, Jr.* did not provide motivation and suggestion of the claimed subject matter. Naturally, to explain what each reference teaches, Appellants had to discuss each reference individually in terms of what the references taught. However, Appellants argued that the combination of *Srinivasan et al.* and *Spikes, Jr.* did not render the claims obvious contrary to the unsupported advocation by the Board.

In regards to the combination of *Srinivasan et al.* and *Spikes, Jr.*, the Board concludes that *KSR* supports the Examiner's reliance on *Spikes, Jr.* only for the teaching of a pre-polishing step (*See* Decision on Appeal decided January 30, 2008, page 6) and therefore affirmed the Examiner. It is respectfully asserted that the Board has not considered *Spikes, Jr.* as a whole which is easily ignored when motivation and suggestion are ignored.

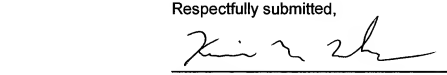
As the Board well knows, "The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way."

(*See* M.P.E.P. § 2141(I)). According to the USPTO's own guidelines for following the *Graham* framework, a "prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)" (*See* M.P.E.P. § 2141.02(VI)) (emphasis in original).

It is respectfully asserted that the Board has not considered *Spikes, Jr.* as a whole, but rather, a single element has simply been pulled from *Spikes, Jr.* Appellants respectfully assert that when considering *Spikes, Jr.* as a whole, one of ordinary skill in the art would utilize the second polishing step as a slurryless polishing step. When considering *Spikes, Jr.* as a whole, "the second polishing process may be used to planarize the first post-polish surface" (*See* column 9, lines 51-52). Without using slurry in the second polishing step, "the first and second dishing non-uniformities 126, 130, may be shielded from the second polishing pad by the thicker portions of the first process layer" (*See* column 9, lines 56-58). Additionally, "because slurry is not used during the second polishing process, the thicker portions of the first process layer 96 may be abraded without substantially affecting the lower regions of the first process layer" (*See* column 9, lines 59-62). Thus, when the first polishing step of *Spikes, Jr.* is inserted into *Srinivasan et al.*, the second polishing step (*i.e.*, *Srinivasan et al.*'s only polishing step) would contain slurry and affect lower regions, which *Spikes, Jr.* expressly teaches against.

Having reviewed the Board's Opinion, and having demonstrated grounds for patentability, Applicants respectfully request reconsideration of the decision and reversal of the rejection of claims 1-25 and 30-38.

Respectfully submitted,



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